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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/772,646	01/30/2001	Stephen J. Boies	YOR920000605US1	2755
35526	7590	02/28/2006	EXAMINER	
DUKE. W. YEE YEE & ASSOCIATES, P.C. P.O. BOX 802333 DALLAS, TX 75380			CABRERA, ZOILA E	
			ART UNIT	PAPER NUMBER
			2125	

DATE MAILED: 02/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/772,646

Applicant(s)

BOIES ET AL.

Examiner

Zoila E. Cabrera

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-94, 129-176 and 178-190 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-7, 10-21, 23-25, 28-39, 43-54, 58-68, 72-82, 86-94, 129-176 and 178-190 is/are rejected.
- 7) ☒ Claim(s) 4, 8, 9, 22, 26, 27, 40-42, 55-57, 69-71 and 83-85 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Final Rejection

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-94, 129-176, and 178-190 are remained for consideration.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 5-7, 13-21, 23-25, 31-39, 46-54, 61-68, 75-82, 89-94 are rejected under 35 U.S.C. 102(e) as being anticipated by **Lof et al. (US 6,671,585 B2)** in view of **Yabutani et al. (US 6,775,595)**.

Regarding claims 1, 19 and 37, **Lof** discloses a method, system and computer program product for managing a utility service, comprising the steps of:

- analyzing relationship information representing a relationship of availability of the utility service and consumption of the utility service (Col. 13, lines 37-46; Col. 16, lines 35-42); and, sending a message over a data network to at least one region of a utility service network to thereby modify utility service consumption based on the analysis of the relationship information (Col. 16, lines 40-58 and lines 64-67,

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please note that load shedding takes place at times of lowered production capacity wherein a message has to be sent in order to cut back the power to certain customers who have agreed to have their power cut back. See also Col. 11, lines 62-65; Col. 12, lines 25-31 and 43-45, i.e., the utility consumption of the hydroelectric would be modified according to the needs of the wind farm).

Regarding claims 2-3, 5-7, 13-18, 20-21, 23-25, 31-36, 38-39, 46-51, 53-54, 61-65, 67-68, 75-79, 81-82, 89-93, **Lof** discloses,

- the message instructs at least one region permitting increased power consumption (Col. 1, lines 65- Col. 12, line 2);
- the message instructs at least one region permitting decreased power consumption (Col. 12, lines 25-31; Col. 13, lines 41-46);
- the message modifies permitted power consumption for aggregated regions (Col. 16, lines 40-42, i.e., aggregated regions reads on any customer who has a contract in any region wherein the power is modified as agreed in the contract).
- the data network is the Internet (Col. 13, lines 5-9);
- the data network includes **at least one of** a wireless link (Col. 13, lines 12-14) and a Bluetooth connection;
- the data network contains at least one link sharing physical wiring with the utility service network (Col. 13, lines 5-12).
- sending the message to at least one region includes broadcasting the message to multiple regions (Fig. 22, steps 2201-2205, please note that message is sent to one or a group of candidate existing providers);

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- transmitting the message as a multicast message to multiple regions (Fig. 22, steps 2201-2205, please note that message is sent to one or a group of candidate existing providers);
- the utility service is providing electricity (Col. 12, lines 25-31);
- at least one region is one of a single power consuming device, a subset of a plurality of power consuming devices, a portion of the utility service network in a geographic region, and a consumption management service provider (Col. 12, lines 59-67);
- the message instructs at least one region to modify at least one term or condition of sale (Fig. 27A, step 2701; Fig. 28B step 2817);
- the term or condition of sale is at least one of price and a pricing method (Fig. 28B step 2817);
- modifying at least one term or condition of sale includes varying the price of the utility service based on a rate of consumption of the utility service (Col. 32, lines 9-21);
- analyzing historical data relating conditions of sale of the utility service to consumption levels of the utility service; and generating the message based on the analysis of the relationship information and the analysis of the historical data (Fig. 4, DAY BEFORE DELIVERY; DAY OF DELIVERY; DAY AFTER DELIVERY; CONSUMPTION FORECAST; COMMERCIAL TRADING; PRODUCTION PLANS; Col. 6, lines 38-60).

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Regarding claims 52, 66, 80, and 94, **Lof** teaches, a method, apparatus and readable medium for managing consumption of a utility, comprising:

- receiving a message from a utility service provider (Col. 33, lines 43-48, i.e., control message is sent to the alternative energy production facility); generating at least one message for at least one region of a utility service network, the at least one message instructing a region to modify utility consumption by the at least one region; and sending the at least one message to the at least one region (Col. 33, lines 58-65; Col. 12, lines 25-31).

However, Lof does not disclose said message including instructions for modifying utility service consumption of the appliance based on the analysis of the relationship information. But Yabutani discloses an energy saving service wherein a supervised load or appliance such as a motor is provided with inverter control operation data to save energy (Col. 3, lines 5-15). Yabutani discloses that a merit refund corresponding to the saved electric power consumption is calculated by referring to the difference between the present electric power consumption data and the inverter control operation data (Col. 3, lines 25-29, please note that the inverter control operation data would modify the energy of the appliance so that savings can be calculated). Yabutani further discloses that the inverter control operation data is collected from the supervisory system through a communication means (Col. 3, lines 50-55).

Therefore, it would have been obvious to a person of the ordinary skill in the art at the time the invention was made to combine the system of Lof with the system for

saving energy of yabutani because it would provide an improved energy system wherein the user would be allowed to obtain a desired energy saving service (Col. 2, lines 1-5).

3. Claims 10-12, 28-30, 43-45, 58-60, 72-74, 86-88, 129-176, and 178-190 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Lof et al. (US 6,671,585 B2)** and **Yabutani (US 6,775,595)** as applied to claims above and further in view of **Johnson et al. (US 2004/0015433 A1)**.

Regarding claims 10-12, 28-30, 43-45, 58-60, 72-74, 86-88, 129-176, and 178-190, the same citations applied to claims 1-9, 13-27, 31-42, 46-57, 61-71, 75-85, 89-94, above apply as well for these claims. However, **Lof** and **Yabutani** fail to disclose associating a customer system with a *class of utility service*; identifying a class of utility service, and *changing the class of utility service*. **Lof** and **Yabutani** further fail to disclose auctioning or negotiating a class of utility service and changing dynamically or unilaterally the class of utility service; the change of class of utility service is based on a cost increase, decrease or available amount of utility service. **Lof** and **Yabutani** further fail to disclose auctioning or negotiating a class of utility service; and changing dynamically or unilaterally the class of utility service; the change of class of utility service is based on a cost increase, decrease or available amount of utility service.

But **Johnson et al.** discloses associating a customer system with a *class of utility service* and identifying a class of utility service, and *changing the class of utility service* (Page 4, [0021]; Page 2, [0009], lines 4-11). **Johnson** further discloses auctioning or

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negotiating a class of utility service (Page 3, [0017], lines 10-20; Page 4, [0019]); and changing dynamically or unilaterally the class of utility service (Page 2, [0012]); the change of class of utility service is based on a cost increase, decrease or available amount of utility service (Page 5, [0042], lines 21-46; [0025]).

Therefore, it would have been obvious to a person of the ordinary skill in the art at the time the invention was made to combine the power production facility of **Lof** and **Yabutani** with the bidding for energy supply to customers system of **Johnson** because it would provide an auction service that will stimulate competition and facilitate the consumer's ability to make economic choices between providers (**Johnson**, Page 3, [0017], lines 10-20).

Allowable Subject Matter

4. Claims 4, 8-9, 22, 26-27, 40-42, 55-57, 69-71, 83-85 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

5. Applicant's arguments filed December 1, 2005 have been fully considered but they are not persuasive. Applicant contends Regarding independent claims 1, 19 and 37, pages 27-34, the following:

Examiner ignored features of claim 1, such as an appliance operably connected to the utility service. Examiner disagrees because "a load" reads on the broadly recited limitation of "appliance". With respect to limitations of analyzing relationship information

representing a relationship of availability of the utility service and consumption of the utility service is taught by Lof (Col. 13, lines 37-46; Col. 16, lines 35-42).

Applicant further contends that neither Lof or Yabutani teach “a relationship of availability of a utility service and consumption of the utility service by an appliance operably connected to the utility service” Examiner disagrees because Lof teaches that the processor 500 may use the data from the meteorological data source/service to predict the amount of surplus/shortfall that will need to be addressed at some predetermined time in the future (Col. 3, lines 37-46). Please note that an analysis takes place of surplus/shortfall or availability or consumption of utility on a load or appliance.

Applicant contends that Yabutani does not teach a message for modifying utility service consumption of an appliance based on analyzed relationship information” Examiner disagrees because Yabutani discloses that a merit refund corresponding to the saved electric power consumption is calculated by referring to the difference between *the present electric power consumption data* and the inverter control operation data (Col. 3, lines 25-29, please note that the inverter control operation data would modify the energy of the appliance or load so that savings can be calculated). Furthermore, Yabutani discloses that “the service provider measures the present electric power consumption of the facility of the user wishing to achieve the energy saving, or *modifies its electric power consumption by considering various variable factors, and then estimates the present electric power consumption*” (Col. 6, lines 17-23). Please note that the service provider has to consider “availability” of the electric

power in order to offer energy savings. If there is no available electric power to offer how the service provider can offer any savings?

Applicant contends that Yabutani does not teach a message for modifying utility consumption of an appliance. As previously stated, "the service provider measures the present electric power consumption of the facility of the user wishing to achieve the energy saving, or *modifies its electric power consumption by considering various variable factors, and then estimates the present electric power consumption*" (Col. 6, lines 17-23). The inverter controller would definitely send a message to the load or appliance to control speed of the load. Such instructions or message would result in savings on energy (Col. 6, lines 36-66).

Applicant contends that the proposed combination does not result in the claimed invention. Examiner disagrees as discussed in the preceding paragraphs under "Arguments".

Applicant contends that there is no motivation, teaching or suggestion to combine the references because the references address different problems. Examiner disagrees because both references are directed to saving energy of a load.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a

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reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Examiner concludes that the broadly limitations of claims 1, 19 and 37 are taught by Lof and Yabutani.

Applicant contends regarding claims 52, 66, 80 and 94, pages 35-38, that Lof and Yabutani does not teach the feature of “generating a message for a region of utility service network, the message including instructions for modifying utility consumption of an appliance in the region”. Examiner disagrees because Lof teaches generating a message for a region of a utility service network, the message including instructions for modifying utility consumption in the at least one region (Col. 33, lines 58-65; Col. 12, lines 25-31). Yabutani further teaches a message for modifying utility service consumption of an appliance or load “the service provider measures the present electric power consumption of the facility of the user wishing to achieve the energy saving, or *modifies its electric power consumption by considering various variable factors, and then estimates the present electric power consumption*” (Col. 6, lines 17-23). Applicant contends that in Yabutani an appliance is not concerned with a utility network, much less a region of a utility network. Examiner disagrees, because a remotely located load corresponds to a load or appliance in a certain region that is connected through a network means in order to be controlled.

Applicant contends that the proposed combination does not result in the claimed invention. Examiner disagrees as discussed in the preceding paragraphs under “Arguments”.

Applicant contends that there is no motivation, teaching or suggestion to combine the references because the references address different problems. Examiner disagrees because both references are directed to saving energy of a load.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In response to applicant statement that the claimed invention solves a problem not recognized by the references, Examiner reiterates that both references are directed to controlling or monitoring the loads or appliances for saving energy.

Applicant contends, regarding claims 2, 3, 18, pages 38-41, the following:
As for claims 2-3, that neither Lof nor Yabutani teach or suggest that a message includes instructions for permitting increased or decreased power consumption. Examiner disagrees because by asking the hydroelectric plant to output sufficient power to compensate for the short fall reads on a message or instruction to output sufficient or increased power to compensate for the short fall (Col. 11, line 65 to Col. 12, line 2). Regarding the decreased power consumption, Lof teaches that the premier power facility communicates a condition to the control center which sends a message to the

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plant requesting the plant to produce lesser or decreased electric power (Col. 12, lines 25-31; Col. 13, lines 41-46).

As for claim 18, Applicant further contends that neither Lof nor Yabutani teach or suggest analyzing historical data relating conditions of sale of the utility service to consumption levels of the utility service. Examiner disagrees because Lof teaches such limitations (Fig. 4, DAY BEFORE DELIVERY; DAY OF DELIVERY; DAY AFTER DELIVERY; CONSUMPTION FORECAST; COMMERCIAL TRADING; PRODUCTION PLANS; Col. 6, lines 38-60).

Applicant contends, regarding claims 10-12, 28-30, 43-45, 58-60, 72-74, 86-88, 129-176 and 178-190, Pages 42-50, the following:

As for claim 129, applicant argues that neither Lof nor Yabutani nor Johnson, teach or suggest the features of associating a customer system with a class of utility service or changing a service parameter of the utility service provided to the customer system in response to a change in the operation of the utility system, and in further response to the class of utility service associated with the customer system. Examiner disagrees because Yabutani teaches changing a service parameter of the utility service provided to the customer system in response to a change in the operation of the utility system (the service provider measures the present electric power consumption of the facility of the user wishing to achieve the energy saving, or *modifies its electric power consumption by considering various variable factors, and then estimates the present electric power consumption*"; Col. 6, lines 17-23). Johnson discloses associating a customer system with a class of utility service and identifying a class of utility service,

and changing the class of utility service (Page 4, [0021]; Page 2, [0009], lines 4-11).

Applicant argues that nothing in Johnson teaches or suggests associating a customer system with a class of utility system. Examiner disagrees because Johnson discloses that electric power and different tariffs are charged to **different classes of end users** (Please note that a utility system has to be associated with a class of users, industrial or residential, in order to receive energy.). Furthermore, Johnson teaches or suggests associating a customer computer connected to a computer or computer server affiliated with an electrical utility (Fig. 1, End User, computer 8, moderator 1, EP or Electrical Provider).

In response to applicant statement that the proposed combination does not result in the claimed invention, Examiner reiterates that Yabutani teaches the change of the service parameter and Johnson teaches associating a customer with a class of utility service (industrial or residential).

In response to applicant statement of no motivation, teaching or suggestion exists to combine the references because the references address different problems. Examiner disagrees because both references are directed to providing energy at a lower cost.

In response to applicant statement that the claimed invention solves a problem not recognized by the references, Examiner reiterates that both references are directed to providing energy at a lower cost.

Applicant contends, regarding dependent claims 130 and 132, that Lof, Yabutani and Johnson teach or suggest an association of a customer system with a class of utility

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service is dynamic and the class of utility service provided to the customer system is based on a cost increase in utility service. Examiner disagrees because Johnson discloses that electric power and different tariffs are charged to **different classes of end users** (Please note that a utility system dynamically has to be associated with a class of users, industrial or residential, in order to receive energy.). Johnson further discloses that the change of class of utility service is based on a cost increase in utility service ([0042], i.e., the best economic value reads on a cost increase. Please note that a best economic value may correspond to a cost increase and not necessarily to the lowest costs).

Lastly, regarding claims 10-12, 28-30, 43-45, 58-60 and 72-74, Pages 52-57, applicant contends the following:

As for claim 10, applicant contends that the Examiner ignored features of claim 10, such as “modifying utility service consumption in a region of a utility service network”.

Examiner disagrees because Lof discloses modifying utility consumption in the at least one region of a utility service network (Col. 33, lines 58-65; Col. 12, lines 25-31).

Applicant further contends that Examiner ignored features such as “classifying a region of a utility service network in a class of service. Examiner disagrees because Johnson discloses that electric power and different tariffs are charged to **different classes of end users** (Please note that a utility system has to be associated with a class of users, industrial or residential, in order to receive energy. Fig. 1). Furthermore, Johnson teaches or suggests associating a customer computer connected to a computer or

computer server affiliated with an electrical utility (Fig. 1, End User, computer 8, moderator 1, EP or Electrical Provider).

Applicant further contends that the proposed combination does not teach all of the features of claim 10. Examiner disagrees as stated in the previous paragraph.

In response to applicant statement that the proposed combination does not result in the claimed invention and that no motivation, teaching, or suggestion exist to combine the references because the references address different problems. Examiner disagrees because Lof, Yabutani and Johnson are directed to providing energy at a lower cost.

In response to applicant statement that the claimed invention solves a problem not recognized by the references. Examiner disagrees because as broadly recited in claim 10, the references of Lof, Yabutani and Johnson disclose such limitations as previously discussed.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning communication or earlier communication from the examiner should be directed to Zoila Cabrera, whose telephone number is (571) 272-3738. The examiner can normally be reached on M-F from 8:00 a.m. to 5:30 p.m. EST (every other Friday).

If attempts to reach the examiner by phone fail, the examiner's supervisor, Leo Picard, can be reached on (571) 272-3749. Additionally, the fax phones for Art Unit 2125 are (571) 273-8300. Any inquiry of a general nature or relating to the status of this application should be directed to the group receptionist at (703) 305-9600.

A handwritten signature in black ink, appearing to read 'Zoila Cabrera', enclosed within a hand-drawn oval.

Zoila Cabrera
Patent Examiner
2/21/06